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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) ER1 0006US	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>12/7/05</u> Signature <u><i>Rebekah Glass</i></u> Typed or printed name <u>Rebekah Glass</u>		Application Number 10/085,497	Filed 2/26/2002
		First Named Inventor Mark A. Tschiegg Art Unit 2167	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input type="checkbox"/> attorney or agent of record. Registration number _____ <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>40309</u>		<u><i>David M. Huntley</i></u> Signature David M. Huntley Typed or printed name 509-324-9256 Telephone number <u>12/7/2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks are being submitted with a Notice of Appeal and a Request for Pre-Appeal Brief Conference. On the basis of these submissions, the Applicant respectfully requests that the Patent Office conduct a Pre-Appeal Brief Conference in the above-captioned application, and, as a result of such Conference, remove the rejections made in a Final Office Action dated June 7, 2005 and pass the application to allowance. The rules setting forth the basis of a Pre-Appeal Brief Conference can be found in the Official Gazette (OG) Notice of July 12, 2005.

Procedurals Facts and the Issue on Appeal

The claims all stand finally rejected under 35 U.S.C. § 103 as being obvious in view of U.S. Published Patent Application No. 2002/0198750 to Innes et al. (referred to below as "Innes") in combination with various secondary references. As set forth in the initial Response filed on January 31, 2005, the subject matter of the Innes published application and the present claimed invention were, at the time the invention was made, subject to an obligation of assignment to the General Electric Company of Schenectady, New York. Therefore, under the provisions of 35 U.S.C. § 103(c), the Innes published application is not a valid reference against the claimed invention in making an obviousness rejection. To provide evidence supporting the above statement, Applicant submitted various exhibits in a first After-Final Response on September 7, 2005, and resubmitted the same exhibits (by reference) in another After-Final Response on November 7, 2005. In an Advisory Action dated November 23, 2005, the Patent Office

entered the November 7, 2005 After-Final Response, and thus, also entered the exhibits filed on September 7, 2005.

Basis for Requesting the Pre-Appeal Brief Conference

According to above-referenced OG Notice of July 12, 2005, a Pre-Appeal Brief Conference is appropriate when there is "a clear deficiency in the prima facie case in support of a rejection." In the instant case, the Applicant submits that the Patent Office's position is clearly improper based on errors in the application of law and the explicit procedures set forth in the Manual of Patent Examining Procedure (MPEP). Therefore, the Applicant submits that it is appropriate to resolve the above-stated issue using the forum of the Pre-Appeal Brief Conference.

The Clear Deficiency in the Final Rejection

The Patent Office continues to maintain the 35 U.S.C. § 103 rejections for the reasons stated in the November 23, 2005 Advisory Action, reproduced below:

The request for reconsideration has been considered but does NOT place the application in condition for allowance because: There mere fact that the reference patent or application publication which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit or declaration under 37 CFR 1.131, in the absence of showing under 37 CFR 1.132 that the patentee derived the subject matter relied on from applicant note MPEP 715.01(b) and 716.10. Applicant has not submitted evidence that Innes et al. reference and present claimed invention are commonly assigned; the claims stand rejected as outlined in the final office action mailed June 7, 2005.

There are two components to this position: (1) The Patent's Office's application of 37 CFR § 1.131 or 37 CFR § 1.132 considerations to address the Applicant's attempt to overcome the rejection under the provisions of 35 U.S.C. § 103(c); and (2) The Patent Office's statement that Applicant has not submitted evidence that Innes and the present claimed invention are commonly assigned.

As to the first position, the Patent Office will note that the Applicant has clearly chosen to overcome the rejection under the provisions of 35 U.S.C. § 103(c), not 37 CFR § 1.131 or 37 CFR § 1.132. These are independent bases for overcoming a rejection. Although an affidavit is required by 37 CFR § 1.131 and 37 CFR § 1.132, it is not generally required by the provisions of 35 U.S.C. § 103(c). Indeed, the very portion of the MPEP cited by the Examiner (MPEP § 715.01(b)) makes this abundantly clear when the last two sentences of this section are also quoted:

Where, however, a rejection is applied under 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/ 103, or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/ 103 using the reference, a showing that the invention was commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. See MPEP § 706.02(I) and § 706.02(I)(1).

This passage makes it clear that the provisions of 37 CFR § 1.131 or 37 CFR § 1.132 do not apply to the issue at hand, namely the adequacy of the submitted evidence under the provisions of 35 U.S.C. § 103(c).

As to the second issue, the Applicant has indeed submitted sufficient evidence to overcome the 35 U.S.C. § 103 rejections based on Innes. MPEP § 706.02(I)(2) (Rev. 2, May 2004, p. 700-55) sets forth that Applicant's properly worded statement "alone

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is sufficient evidence to disqualify" a reference from being used in a rejection under 35 U.S.C. § 103(a). The MPEP continues by stating that the Examiner's request for additional evidence may be appropriate for "rare instances" in which the Examiner has "independent evidence" that raises a material doubt as to the accuracy of Applicant's representations. There is no such showing by the Patent Office that this circumstance applies here.

Moreover, the Applicant has submitted various exhibits to help establish the factual basis of common ownership. MPEP § 706.02(l)(2) contemplates that the Applicant can establish common ownership by making reference to a variety of evidence, including recorded and unrecorded assignment documents. Accordingly, the submitted evidence, coupled with Applicant's express statements of record, should provide a more than ample basis for removing Innes as a reference.

Request to Withdraw the Final Rejections and Pass the Application to Allowance

For at least the above-stated reasons, the Applicant submits that the rejections are clearly in error as a matter of law and established USPTO procedure. The Applicant therefore respectfully requests the Patent Office to withdraw the 35 U.S.C. § 103 rejections based on Innes and pass the application to allowance without further delay.

Respectfully Submitted,

Dated: December 7, 2005

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